

Docket No. CR50U-US

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REMARKS****RECEIVED
CENTRAL FAX CENTER
APR 02 2007****Status of Claims**

Claims 1-37 are pending in the application.

Claim 1-37 stand rejected.

Claims 19-21 are herein cancelled.

Claims 2-3 are herein amended.

No new matter is added by the amendments herein.

Claim Rejections**35 U.S.C. §112**

The Examiner has rejected claims 2-3 and 19-21 under 35 U.S.C. 112, second paragraph. In response the Applicant has cancelled claims 19-21 and amended claims 2-3. As amended, Applicant respectfully submits that they have traversed the Examiner's rejection as to these claims.

35 U.S.C. §102**U.S. Patent No. 6,264,933 ("933")**

Claims 1-4, 6-9, 23-26, 28 and 32-37 stand rejected as anticipated by '933. The Examiner holds that if we accept that the "wheat protein hydrolysate" set forth in '933 reads on the present invention's effective amount of keratin-conditioning agent, then '933 anticipates the present invention under 35 U.S.C. 102(b). Applicant respectfully traverses this impermissible "expectation" by the Examiner.

An allegedly invalidating reference under must meet all the limitations of the claims on it four corners. There can be no "expecting" as the Examiner suggests, under 102(b).

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More particularly, to anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

The '933 patent does not disclose a keratin conditioning agent in an effective amount for improving the aesthetic appearance of a keratinous fiber, and the Examiner can not guess at an ingredient's function in a composition.

Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. See *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The single source must disclose all of the claimed elements "arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

The reference must, "sufficiently" describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. ("3M") v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1572, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992).

The '933 reference does not describe the present invention, so as to have placed it in the public's possession.

Nothing in '933 discloses the claimed invention (i.e. a mascara base and a keratin conditioning agent in an amount effective to improve the aesthetic appearance of a keratinous fiber as seen in the figures submitted with the application). '933 is a patent directed to waterproof mascara and as is seen in the examples of '933, has very strong film formers, including the wheat protein hydrolysate. The waterproof mascara of the '933 patent, with such strong film formers necessarily teaches away from the present invention. Contrary to the Examiner's assumptions, there is nothing in the '933 reference that supports a finding that the wheat protein hydrolysate is a keratin conditioning agent in the '933 examples. There is nothing in the '933 patent that teaches the conditioning of the keratinous fibers. Nor do the Examiner's expectations regarding the viscosity of the materials of the '933 patent support a finding of anticipation.

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The Examiner's reliance on *In Re Spada*, 911 F.2d 705, 709 (Fed. Cir 1990) is also misplaced. As stated in the portion cited by the Examiner in the Office Action, at page 3, *In Re Spada* is directed to chemical compositions of identical composition. That is not true as to the present invention and the '933 cited patent. Assuming arguendo that the wheat protein hydrolysate of the '933 patent and the wheat protein of the present invention were identical (which they are not), still the remaining portions of the claimed invention are not identical to those compositions disclosed in the '933 patent.

U.S. Patent No. 6,274,131 ('131)

The Examiner has also rejected claims 1-4, 6-10, 23-26, 28 and 32-37 as allegedly anticipated by U.S. Patent No. 6,274,131 ('131) under 35 U.S.C. 102(b). For at least the reasons set forth above, the Applicants respectfully traverse the Examiner's objections. This patent discloses compositions (as in the '131 reference) having very high film formers and as such would not teach a conditioning mascara as in the present invention but rather would teach away from a conditioning mascara. *In Re Spada* is inapplicable in this rejection for at least the same reasons set forth above.

U.S. Patent No. 5,053,221 ('221)

The Examiner has also rejected claims 1-4, 6-10, 23-26 and 32-37 as allegedly anticipated by U.S. Patent No. 5,053,221 ('221) under 35 U.S.C. 102(b). For at least the reasons set forth above, the Applicants respectfully traverse the Examiner's objections. This patent discloses compositions having very drying affects on the keratinous fibers. This reference also discloses the use of alcohols, which are known to be very drying, in mascaras and as such would not teach a conditioning mascara as in the present invention but rather would teach away from a conditioning mascara. *In Re Spada* is inapplicable in this rejection for at least the same reasons set forth above.

35 U.S.C. §103

U.S. Patent Nos. 6,264,933 ('933) and 6,214,329 ('329)

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The Examiner has rejected claims 1-4 and 6-37 as allegedly obvious under 35 U.S.C. 103(a), in light of the '933 patent in combination with the '329 patent. Applicants respectfully traverse this rejection.

As pointed out above the '933 patent teaches away from the present invention and as such there would be not motivation to look to the '933 for the present invention. The '933 patent is directed to a mascara composition(s) that contain harsh ingredients. The present invention in contrast is directed to a mascara which contains conditioning materials and in some instances moisturizing ingredients.

Part of evaluating the invention as a whole includes considering functional language in a claim. The CCPA recognized the propriety of defining an invention by what it does, rather than by what it is. *See In re Caldwell*, 319 F.2d 254, 138 U.S.P.Q. 243 (C.C.P.A. 1963).

Caldwell appealed claims directed to methods of stimulating growth of ruminants, poultry, and swine using "effective amounts" of aspirin in feed rations. The cited art taught administering aspirin to children and rats, without any suggestion of stimulating growth. The PTO rejected the claims, not for any reasons of indefiniteness under § 112, but as obvious over a reference that did not satisfy the claimed functional language. The CCPA reversed, stating "that the *real* novelty is as defined in all of the appealed claims--stimulating the growth of ruminants, poultry, or swine by feeding them aspirin for that purpose. [The prior art] obviously suggests no such method." *In re Caldwell*, 319 F.2d at 257, 138 U.S.P.Q. at 246. In other words, patentability resided in the unobvious use of aspirin for growth promotion, rather than in the amount used. As the court concluded:

"Effective amount" admirably states what is to be derived from the disclosure of the specification as to amount and we can see nothing "critical" about the amount in determining the existence of patentable invention.

Id. at 258, 138 U.S.P.Q. at 247. *See also Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 751-52, 3 U.S.P.Q.2d 1766, 1771 (Fed. Cir. 1987), where the Federal Circuit relied on the functional clause, "so that," to distinguish a reference from the claimed invention.

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As in Caldwell, the present invention lies in the unobvious use of a keratin conditioning agent in an amount effective to improve the aesthetic appearance of keratinous fiber, is not obvious in light of the '933 reference merely disclosing a wheat protein hydrolysate.

As pointed out in Caldwell merely using the same ingredients is not sufficient for obviousness. There must have been a recognition of the benefit of the material in the prior art, which is not true in this Office Action.

As pointed out above the present invention is not obvious in light of the '933 patent and therefore, the invention is also not obvious in light of the '329 patent.

Reconsideration of this rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendments and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

Dated: April 2 2007

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